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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,691	04/17/2001	Donald Soares	52295/00101	7169
26116	7590	02/17/2005	EXAMINER	
SIDLEY AUSTIN BROWN & WOOD LLP 717 NORTH HARWOOD SUITE 3400 DALLAS, TX 75201			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/836,691	SOARES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Edward R. Cosimano	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
**THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 01 February 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-30 and 33-42 is/are pending in the application.  
 4a) Of the above claim(s) none is/are withdrawn from consideration.  
 5) Claim(s) 1-7,17-22,28,29 and 34-41 is/are allowed.  
 6) Claim(s) 8-16,23-26,30 and 33 is/are rejected.  
 7) Claim(s) 27 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

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1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The Finality of the last Office action is withdrawn in view of the following rejections.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. Claims 8-16, 23-26, 30 & 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - 4.1 In regard to claims 8-16, 23-26, 30 & 33, although one of ordinary skill at the time of the invention would known how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:
    - A) in regard to claim 8, and why a "second estimated price" has been determined/calculated, since claim 1 already has calculated a "second estimated price" in regard to the "second printer".
    - B) in regard to claims 9 & 10, and which "second estimated price" is used in these claims, since both claims 1 & 8 calculated a "second estimated price".

C) in regard to claims 11-13 & 23-25, and how the "selections of the buyer" (claims 11 & 23) or the "attributes desired by the buyer" (claims 12 & 24) or the "geographical location of said first and second printers relative to the buyer" (claim 13) or the "set of specifications" (claim 25), may be used to designate/select the fist printer and second printer, since the invention as recited in these claims fails to enter and/or acquire and/or determine and/or set forth at least:

- (1) the "buyer's selection"; or
- (2) the "desired attributes"; or
- (3) the "location" information; or

(4) any information that would be required to determine the ability of a printer to produce a print job with the required specifications;  
as would be required by the recited system/method in order to make the recited selection and/or determinations.

D) in regard to claims 14-16 & 26, and how the "first printer" and "second printer" can be "prequalified", since the invention as recited in these claims fails to acquire and/or determine and/or set forth the information that would be required by the system in order to make the recited qualification determination.

E) in regard to claim 30, and why the buyer would pay the vendor of the raw materials, since as recited in claim 28, the raw materials are purchased by the printer designated to perform the print job.

F) in regard to claim 33, and:

- (1) a "pricing model" may be used to determine an estimated "first price"; or
- (2) how the "first set of specifications" may be used to determine an estimated "first price"; or
- (3) how the "first set of specifications" may be modified into a "second set of specifications"; or
- (4) how a "estimated second price" based on the "second set of specifications" may be compared to an "invoice price";

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since the invention as recited in these claims fails to enter and/or acquire and/or determine and/or set forth either a "pricing model" a "set of specifications for a print job" or an "invoice price" as would be required by the recited system/method in order to make the recited calculations and/or estimations and/or modifications and/or comparison.

4.2 In regard to claims 8-10, and applicant's references to a "second estimated price" is confusing, since claim 1 already has calculated a "second estimated price" in regard to the "second printer".

4.3 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

5.1 Claims 8-16, 23-26, 30 & 33 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

5.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an

obstruction in an open channel to affect flow in a predetermined manner comprising:

- a) obtaining the dimensions of said obstruction which affect the parameters of flow;
- b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;
- c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter
- d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

5.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims where not a

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process with in the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

5.1.3 As can be seen from claims 8-16, 23-26, 30 & 33, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 8-16, 23-26, 30 & 33 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process with in the meaning of machine or process as used in 35 U.S.C. § 101.

5.2 Claims 8-16, 23-26, 30 & 33 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 8-16, 23-26, 30 & 33, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.

6. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Farrell (5,383,129), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job.

(2) Akita (JP 10-171875), which discloses using a stored bill/charge/rate information and the specifications of a manufacturing job to estimated the cost of the manufacturing job as well as the required raw materials.

(3) either Maruta (6,064,838) or Antoniak or Sevcik et al (6,330,542), which discloses using a stored bill/charge/rate information and the specifications of a print job to estimated the cost of the printing job, where the operator may change the specifications of the print job before the job is started.

(4) Watanabe (JP 2001-92616), which discloses using a stored bill/charge/rate information and the specification of a print job sent over a network to estimated the cost of the printing job.

(5) either Quallen et al (2002/0128953) or Soars et al (2002/0152183), which discloses using a stored bill/charge/rate information and the specifications

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of a print job to estimated the cost of the printing job, where the buyer and seller may negotiate the estimate.

B) however, in regard to claims 1, 21 & 34, the prior art does not teach or suggest a printing job cost estimating system in which a central location:

(1) uses the specifications that describe a print job, as received from a buyer, to determine an estimated cost for producing the print job by a number of print providers by using the respective cost data provided by the respective print providers;

(2) notified the buyer of at least the lowest cost estimate; and

(3) permits the print providers and the buyer to negotiate the print job specifications and cost estimates in order to select a print provider for producing the print job.

Claims 2-20, 22-30, 35 & 36 are allowable for the same reason.

C) however, in regard to claims 31 & 33, the prior art does not teach or suggest a printing estimating system in which:

(1) a first estimated cost of a print job is determined based on received set of specifications for a print job,

(2) the received set of specifications for the print job is modified into a second set of specifications for the print job and a second estimated cost of the print job is determined based on second set of modified specifications for the print job; and

(3) the invoice of the print provider is determined to be in compliance with a pricing model if actual cost of producing the print job is not substantially greater than the second estimated cost of producing the print job.

Claim 32 is are allowable for the same reason.

D) however, in regard to claim 37, the prior art does not teach or suggest a printing job cost estimating system in which a central location:

- (1) uses the specifications that describe a print job, as received from a buyer, to determine an estimated cost for producing the print job by a print provider by using the respective cost data provided by the print provider;
- (2) notified the buyer of at least the cost estimate; and
- (3) permits the print provider and the buyer to negotiate the print job specifications and cost estimates in order to select a print provider for producing the print job.

Claims 38-41 are allowable for the same reason.

7.

Response to applicant's arguments.

7.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (703) 746-7240.

9.2 The fax phone number for **OFFICIAL FAXES** is (703) 872-9306.

9.3 The fax phone number for **AFTER FINAL FAXES** is (703) 872-9306.

02/14/05

*Edward Cosimano*  
Edward R. Cosimano  
Primary Examiner A.U. 3629